

### **Remarks**

Claims 1-25 are pending in the application. Claims 1-22 and 24-25 were rejected and claims 23 was allowed. By this Amendment, claims 1-5, 9-11, 17, 20 and 21 have been amended. Reconsideration of the claims is respectfully requested. No new matter has been added.

#### **Rejection Under 35 U.S.C. §112**

Claims 17 and 21 were rejected under 35 U.S.C. § 112, second paragraph as lacking antecedent basis. Claim 17 has been amended to recite first and second connecting layers with appropriate antecedent basis. Claim 21 has been amended to depend on claim 10, which provides antecedent basis for "the connecting layer". Consequently, Applicants believe this rejection has been cured.

#### **Rejection Under 35 U.S.C. § 102**

Claims 1-4, 6-7, 10-12, 14 and 18 were rejected under § 102(b) as being anticipated by U.S. Patent No. 4,541,885 issued to Caudill, Jr. et al. (hereinafter "Caudill '885"). Applicants note that the Examiner withdrew a rejection of the same claims under §103(a) in view of Caudill '885 and two other references in response to the Appeal Brief dated August 8, 2003. Since the Examiner could not maintain the rejection in view of Caudill '885 and with the benefit of other references, it is illogical to propose that a rejection could be maintained in view of Caudill '885 alone.

Applicants have amended claim 1 to recite that the support layer is adapted to be disposed proximate the vehicle roof. Caudill '885 does not disclose a support layer disposed proximate a vehicle roof. Instead, Caudill '885 recites a seat cover assembly having an upper layer (20) disposed proximate a cover layer (28) and a lower layer (22) disposed proximate a sheeting layer (26) (see column 3, lines 36-38, 53-54, 58-60, and Figure 1). The relationship between the support layer and the vehicle roof is recited in the body of the claim and must be given patentable weight. Consequently, Applicants believe this rejection has been

overcome. Since claims 2-22 depend on claim 1, the rejection of these claims is believed to be overcome for the same reasons.

**Rejection Under 35 U.S.C. § 103**

Claims 1, 5, 13, and 19-20 were rejected under § 103(a) as being unpatentable over Caudill '885. The rejection of claim 1 is believed to be overcome for the reasons stated above. Consequently, the rejection of dependent claims 5, 13, 19, and 20 is believed to be overcome for the same reasons. In addition, the following arguments are presented.

Regarding claim 1, the Examiner has not modified or supplemented the rejection of claim 1 in any manner. Consequently, a *prima facie* case has not been established for a new rejection of claim 1 under §103(a).

The Examiner failed to provide any support for the rejection of claims 5 and 20. Moreover, Caudill '885 does not teach or even remotely suggest any material thickness ratios as required by claims 5 and 20. Consequently, a *prima facie* case has not been established and request that this rejection be withdrawn.

The Examiner failed to provide any support for the rejection of claim 13. Moreover, Caudill '885 does not teach or even remotely suggest upper and lower foam panels having different porosities as required by claim 13. Consequently, a *prima facie* case has not been established and request that this rejection be withdrawn.

The Examiner improperly ignored claim language in rejecting claim 19. Claim 19 recites a support layer having "a flexural strength greater than the decorative layer and the intermediate layer." The Examiner admitted that Caudill '885 "does not disclose that the support layer having greater flexural strength than the decorative and intermediate layers" (see Office Action, page 5). However, the Examiner for the first time argues that flexural strength is an optimizable feature. The Examiner ignores that fact that no "optimum values" are mentioned in claim 19 or even remotely suggested by Caudill '885. Moreover, the different

flexural properties are directed toward providing a solution to the problem of providing a vehicle roof liner with improved geometric adaptability and increased acoustic absorption, which is not suggested or even remotely suggested by Caudill '885 (see Appeal Brief, page 5). As such, the Examiner has mischaracterized the language of claim 19 and has not established a *prima facie* case. Applicants request that this rejection be withdrawn.

Claims 1, 8, 16 and 22 were rejected under § 103(a) as being unpatentable over Caudill '885 in view of U.S. Patent No. 4,541,885 issued to Ohta et al. (hereinafter "Ohta '885"). The Examiner has not modified or supplemented the rejection of claim 1 in any manner. Consequently, Applicants reiterate the arguments previously presented that a *prima facie* case has not been established for a new rejection of claim 1. Claims 8, 16, and 22 depend on claim 1. Consequently, the rejection of these claims is believed to be improper for the same reasons.

Claims 1, 8, 9, 15, and 24-25 were rejected under § 103(a) as being unpatentable over Caudill '885 in view of Ohta '019 and further in view of U.S. Patent No. 4,479,992 issued to Häseker et al. (hereinafter Häseker '992). The rejection of claim 1 is believed to be overcome for the reasons previously stated. Moreover, in the Appeal Brief dated August 8, 2003, it was shown that the Examiner failed to establish proper motivation for combining Caudill '885 with Häseker '992. The arguments are repeated below.

The Examiner failed to establish proper motivation for combining Caudill '885 with Häseker '992. Both independent claims involved in the appeal are directed to a vehicle roof liner and require a support layer that includes a lower foam panel and an upper foam panel. Specifically, claim 1 recites an "interior lining component for a vehicle roof" that includes a support layer having "at least one lower and one upper foam panel" and claim 23 recites an "inside roof lining for a vehicle" that includes a support layer having "a lower foam panel [and] an upper foam panel." Because Häseker '992 does not disclose a support layer including a lower foam panel and an upper foam panel, the Examiner proposed to combine Caudill '885 with Häseker '992. In the final Office Action mailed on May 9, 2003, the

Examiner acknowledged that Caudill '885 is not directed toward a vehicle roof liner, but argued that there was motivation to combine the references since "both references are laminates and each have a support system" (see page 5 of the final Office Action).

Applicants respectfully believe that there is no suggestion or motivation for combining Caudill '885 with Häseker '992. As noted by the United States Court of Appeals for the Federal Circuit, there are three possible sources for a motivation to combine references: "the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

In this case, the cited references are directed to different problems. Specifically, Caudill '885 is directed to the problem of adding decorative embossing to a vehicle seat cover using dielectric embossing technology, while Häseker '992 is directed to providing an acoustically effective lining component for a vehicle roof or engine space. Therefore, the nature of the problem to be solved is not a source for motivation to combine Caudill '885 and Häseker '992.

With respect to the second possible source for motivation, there is no teaching in Caudill '885 of applicability outside of the automotive seat art. More specifically, Caudill '885 does not teach or even remotely suggest the use of the disclosed dielectrically embossed seat cover assembly as a roof liner.

In addition, Häseker '992 actually teaches away from its combination with Caudill '885. Specifically, the Examiner argued that "the polyurethane foam used in the support system of the Caudill reference provides stiffness and rigidity" (see page 5 of the final Office Action). In contrast, Häseker '992 discloses that a polyurethane foam layer "fails completely in the strength test, corresponding to a pronounced sag in one direction" (see column 4, lines 6-12 and lines 46-47). Consequently, Häseker '992 teaches that a polyurethane foam layer, such as that in Caudill '885, is undesirable for use with the support

system disclosed in Häseker '992. As a result, the teachings of the prior art are not a source for motivation to combine Caudill '885 and Häseker '992.

In addition, the Examiner failed to identify or explain any specific understanding or principle within the knowledge of a skilled vehicle roof liner artisan that would motivate one with no knowledge of the present invention to make the combination. Instead, the Examiner has engaged in impermissible hindsight analysis by looking to the present invention for the insight to combine the seat foam laminate of Caudill '885 with the vehicle roof liner of Häseker '992.


For these reasons, Applicants respectfully believe that one skilled in the vehicle roof liner art would not be motivated to look to the non-analogous seating art, and more specifically to Caudill '885, for a solution to the problem of providing a vehicle roof liner with improved geometric adaptability and increased acoustic absorption. As a result, Applicants respectfully believe that the Examiner has failed to make a *prima facie* case that claims 8, 9, 15, 24, and 25 are unpatentable under § 103(a) and that the rejection should therefore be reversed.

In addition, the Examiner improperly ignored claim language in claims 24 and 25. Claim 24 recites an interior lining component where "the lower foam panel provides stiffness and the upper foam panel provides acoustic absorption." Similarly, claim 25 recites that "the upper foam panel provides stiffness and the lower foam panel provides acoustic absorption." The Examiner failed to provide any arguments or provide any reference that discloses that a particular foam panel provides acoustic absorption, while another foam panel provides stiffness. As such, a *prima facie* case has not been established and the rejection of these claims must be withdrawn.

**Conclusion**

Applicants have made a genuine effort to respond to the Examiner's rejections in advancing the prosecution of this case. Applicants believe all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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